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DECISION
ON PETITION

Stephen P. Maginas
3404 25th Street
Rock Island IL 61201

In re Application of:
Stephen Paul Maginas
Application Serial No.: 10/092,074
Filed: March 6, 2002
For: **DEVICE AND METHOD FOR REPETITIVE
COMMUNICATION OF MESSAGES**

This is a decision on the petition to withdraw the final action as premature, filed December 8, 2005, pursuant to 37 CFR § 1.181.

Petitioner alleges that the examiner erred in holding the Office action mailed September 2, 2005 final and requests withdrawal of finality of the Office action. It has been contended by the petitioner that words added to the new claims find support in the specification and claims originally filed, no new matter was included, the prior art used was not in an IDS provided by applicants or supplied by the examiner, that the majority of the outstanding Office action addressed issues initially developed and the examiner failed to present the newly cited art in the first Office action.

MPEP §706.07(a) [R-1] Final Rejection, When Proper on Second Action, states in part:
Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.
Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicant admits, and the file record confirms that the originally presented claims 1-20 were cancelled in applicant's response and that new claims 21-31 were presented for examination with claims 21 and 26 being the only independent claims. Therefore, the issue to be addressed in determining the appropriateness of the finality of the September 24, 2005 Office action, is whether or not applicant's response necessitated the examiner's new ground of rejection.

Applicant admits that the amendment to claim 26, "following the word 'whereby', indicated a function well-described in Applicant's specification". Given that applicant has added descriptive language from their specification which was not in an originally presented claim, then applicant has altered the scope of originally presented claim 7.

Regarding applicant's comments with respect to new independent claim 21, applicant is correct that the language of claim 21 incorporates language from canceled claims 1 and 5. However, upon inspection, canceled claim 5 did not depend directly from canceled claim 1. Rather canceled claim 5 indirectly depended from claim 1 via claims 2, 3, and 4. In other words, the limitations of canceled claim 5 included all of the limitations in canceled claims 1, 2, 3 4 and 5. Therefore, applicant's presentation of new claim 21 which only includes the limitations from canceled claims 1 and 5, has altered the scope of previous claim 5 and therefore the claim does not have the same meets and bounds as previously presented.

It is apparent that applicant has cancelled the previously presented claims 1-20 and that newly presented independent claims 21 and 26 have been altered in scope.

Therefore, applicant's amendment necessitated the examiner's new ground of rejection and in accordance with MPEP §706.07(a), the next action was appropriately made final based upon the new grounds of rejection.

Accordingly, the petition to withdraw finality is **DENIED**.

The application file will be forwarded to the examiner for consideration of applicant's amendment after final submitted simultaneously with the subject petition.

A handwritten signature in black ink, appearing to read 'Mark Powell', is written over a horizontal line.

Mark Powell, Director
Technology Center 2600
Communications